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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/891,751	06/26/2001	Dale F. McIntyre	83009F-P	1010

7590 09/22/2004

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EXAMINER

CHANKONG, DOHM

ART UNIT	PAPER NUMBER
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2152

DATE MAILED: 09/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/891,751

Applicant(s)

MCINTYRE ET AL.

Examiner

Dohm Chankong

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 October 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) 1-3 and 13-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 4-12 and 19-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 5/10-15-2001.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

- 1> Claims 1-30 are presented for examination.

#### *Election/Restrictions*

- 2> Restriction to one of the following inventions is required under 35 U.S.C. 121:
- a. [Group 1] Claims 1-3 and 16-18 are drawn to use of a user icon to authorize user access to files where the icon comprises an image of the user, classified in class 340, subclass 5.53 – authentication using user image;
  - b. [Group 2] Claims 4-12 and 19-30 are drawn to communication of the media files over a communication network using an identifier and address associated with the files, classified in class 709, subclass 245 – computer to computer data addressing;
  - c. [Group 3] Claims 13-15 are drawn to processing high and low resolution images, classified in class 382, subclass 299 – image resolution.

The inventions are distinct, each from the other because of the following reasons:

Inventions in groups 1, 2, and 3 are related as subcombinations disclosed as usable together in a single combination. The combinations are distinct from each other if they are shown to be separately usable. In the instant case, Invention 1 has separate utility such as in a system lacking communication of media files over a communication network, high and low resolution images, particulars. Invention 2 has separate utility such as in a system lacking the high and low resolution images, particulars. Invention 3 refers to creation of low resolution images and transmission of high resolution images. See MPEP § 806.05(d).

3> Inventions in groups 1, 2, and 3 are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects. In the instant case, the different inventions are (1) information access with the use of a user icon, (2) data communication over a network with the use of an identifier and associated address, and (3) creation and use of high and low resolution images.

4> Because these inventions are distinct for the reasons given above and have acquired a separate status in the art shown by their different classification, restriction for examination purposes as indicated is proper.

5> Because these inventions are distinct for the reasons given above and the search required for Invention 1 is not required for Inventions 2 and 3, restriction for examination purposes as indicated is proper. In particular, the search for invention 2 would require searching 340/5.53, authorization using images, while inventions 1 and 3 would not. The search for invention 3 would require searching 382/299, image resolution, while inventions 1 and 2 would not. See MPEP § 806.05(d).

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6> A call was place on 9.14.2004 to the attorney of record, Frank Pincelli. A provisional election was made to prosecute Invention 2, claims 4-12 and 19-30, without traverse.

Affirmation of this election must be made by applicant in replying to this Office action. C

7> Claims 1-3, 13-15 and 16-18 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

### *Claim Objections*

8> Claims 6, 9, 11, 24-27 and 30 are objected to because of the following informalities: as they are dependant claims, they refer to methods, systems or products previously claimed by their respective independents; therefore, they should begin with the term 'the' (not 'a') to properly acknowledge this antecedent basis. Appropriate correction is required.

### *Claim Rejections - 35 USC § 102*

9> The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly

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from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

10> Claims 4, 21 and 29 are rejected under 35 U.S.C § 102(e) as being anticipated by Tobita et al, U.S Patent Publication No. US 2002/0009987 A1 ["Tobita"].

11> As to claim 4, Tobita discloses a method for automatically forwarding a digital media file by a first party to a second party over a communication network, said digital media file having at least one digital image file and a digital information file [paragraphs 0014, 0024], comprising the steps of:

analyzing a digital image media file for determining if an image content identifier is present, said image content identifier having an associated electronic address [Figures 4 and 5 | paragraphs 0086 | claim 9 where: the combination of identification information of the image and user identifiers are equivalent to an image content identifier, and the email addresses of the specific persons are equivalent to associated electronic addresses]; and

automatically forwarding said digital image to said electronic address over said communication network if said image content identifier is present [paragraph 0024 where: transmission of the image to the mobile phone is done automatically if the user identifier is present in the database].

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12> As to claim 21, as it is a computer software products that perform the steps of the method of claim 4, they do not teach or further define over the limitations recited in claim 4. Therefore, claims 21 is rejected for the same reasons as set forth in claim 4, supra.

13> As to claim 29, Tobita discloses a method for automatically forwarding a digital media file by a first party to a second party over a communication network, said digital media file having at least one digital image file and a digital information file [paragraphs 0014, 0024], comprising the steps of:

analyzing a digital image media file for determining if an image content identifier is present, said image content identifier having an associated electronic address [Figures 4 and 5 | paragraphs 0086 | claim 9 where: the combination of identification information of the image and user identifiers are equivalent to an image content identifier, and the email addresses of the specific persons are equivalent to associated electronic addresses]; and

automatically forwarding said digital image to said electronic address over said communication network if said image content identifier is present [paragraph 0024 where: transmission of the image to the mobile phone is done automatically if the user identifier is present in the database].

automatically updating said content identifier to reflect a change [paragraphs 0018 and 0028].

14> The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

15> Claims 5-7, 19-20, 23 and 24 are rejected under 35 U.S.C § 102(b) as being anticipated by McCoy et al, U.S Patent No. 6,018,739 ["McCoy"].

16> As to claim 5, McCoy discloses a method for identifying images for communication over a communication network [abstract], comprising the steps of:

displaying a digital image [column 8 <lines 28-33>];

identifying a feature within said digital image [column 8 <lines 36-41> where:

a fingerprint is equivalent to a feature in the digital image];

creating an image content identifier based on said feature [column 8 <lines 41-44>

where: the compressed minutiae, image and textual data is comparable to an image content identifier as it is used by the server to compare the image (fingerprint/face) to stored images in the database];

displaying, transmitting or storing a second digital image based on identifying the image content identifier within said second digital image [column 10 <lines 45-53> where the second digital image is the matching fingerprint].

17> As to claim 6, McCoy discloses the method according to claim 6, wherein the content identifier is based on parameters used for face recognition [column 4 <lines 32-36 and 49-58>].



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18> As to claim 7, McCoy discloses a method for identifying images for communication over a communication network [abstract], comprising the steps of:

analyzing a digital image [column 8 <line 36>];

identifying a feature within said digital image using an image content identifier [column 8 <lines 36-41> where: a fingerprint is equivalent to a feature in the digital image and fingerprint minutiae is equivalent to an image identifier];

displaying, transmitting or storing said image based on identifying the feature within said image [column 3 <lines 24-33>].

19> As to claims 19 and 20, as they are computer software products that perform the steps of the methods of claims 5 and 6 respectively, they do not teach or further define over the limitations recited in claims 5 and 6. Therefore, claims 19 and 20 are rejected for the same reasons as set forth in claims 5 and 6, supra.

20> As to claim 23, McCoy discloses a method for automatically obtaining images from a third party computer for a user over a communication network, comprising the steps of:

providing an image icon by a user on a user computer which identifies a particular type of an image that is to be automatically retrieved [column 4 <lines 45-58> | column 7 <lines 24-30> where: the fingerprint or photograph image is equivalent to an image icon, and they specify the type of matching that is required; for instance, if an fingerprint is submitted to the server, than any matching fingerprint image type is requested];

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forwarding said image icon to a remote site over a communication network [Figure 1  
<items 12a, 13, 11 | column 3 <lines 1-5>];

using said image icon at said remote site for identifying an image in accordance with a  
particular type of image [column 3 <lines 8-16>];

forwarding said identified image to said user over a communication network [column  
11 <lines 29-39>].

21> As to claim 24, McCoy discloses the method according to claim 23, wherein said image  
icon comprises a facial recognition analysis [column 4 <lines 32-36 and 49-58>].

***Claim Rejections - 35 USC § 103***

22> The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all  
obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in  
section 102 of this title, if the differences between the subject matter sought to be patented and the prior art  
are such that the subject matter as a whole would have been obvious at the time the invention was made to a  
person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be  
negativated by the manner in which the invention was made.

23> Claims 8, 25, 27 and 28 are rejected under 35 U.S.C § 103(a) as being unpatentable over  
McCoy.

24> As to claim 8, McCoy discloses a method for creating an image content identifier for  
use in identifying images, comprising the steps of:

displaying a digital image [column 8 <lines 28-33>];

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identifying a feature within said digital image [column 8 <lines 36-41> where:  
a fingerprint is equivalent to a feature in the digital image];

creating an image content identifier [column 8 <lines 41-44> where: the compressed  
minutiae, image and textual data is comparable to an image content identifier as it is used by  
the server to compare the image (fingerprint/face) to stored images in the database];

While McCoy does not explicitly disclose the creation of the identifier by storing the  
pixels which compose the said feature, he does disclose storing digitized images of  
fingerprints or photographs. Since it is well known in the art that digitized images are  
comprised of grid of pixels, one of ordinary skill in the art would have inferred that McCoy  
was storing pixels of the features of the images for the creation of the identifiers.

25> As to claim 25, McCoy does not explicitly disclose the method according to claim 23,  
wherein said user identifies the remote site wherein said image icon is to be placed, but does  
state that the user is signs on to the server with which the user will send the  
fingerprint/photograph information [column 3 <lines 25-29>]. Thus, one of ordinary skill in  
the art would have inferred that the user identifies the remote site by signing onto the server.

26> As to claim 27, McCoy does not explicitly disclose the method according to claim 25,  
wherein said remote site provides consent to have it database of digital images analyzed for  
determining if any images can be identified, but does state that the user is granted access to  
the image databases by the server [column 3 <lines 25-29>]. One of ordinary skill in the art

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would have inferred that the user act of signing on and obtaining access to the server is equivalent in functionality to the remote site providing consent to the user.

27> As to claim 28, McCoy discloses a system for automatically obtaining images from a third party computer for a user over a communication network, comprising:

means for obtaining an image icon stored on a user computer which identifies a particular type of an image that is to be automatically retrieved for said user [column 9 <lines 17-19> where: fingerprint minutiae is comparable to an image icon and the particular type of image is a fingerprint image], said means forwarding said image icon to a remote site over a communication network wherein said remote site uses said image icon of said particular type of image at said remote site for identifying said particular type of image [column 9 <lines 19-23> where: the server uses the fingerprint minutiae to identify possible matching fingerprint images]; said identified image is automatically obtained [column 10 <lines 33-42>].

While McCoy does not specifically disclose a service provider obtaining image icons or forwarding said icons to a remote site, he does disclose that the client obtains the image icon from a local storage. One of ordinary skill in the art would have inferred that McCoy's use of the term 'client' is comparable in functionality to the claimed service provider. Therefore it would have been obvious to one of ordinary skill to implement McCoy's client as a service provider.

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28> Claims 9-12, 22 and 26 are rejected under 35 U.S.C § 103(a) as being unpatentable over McCoy, in view of Tobita.

29> As to claim 9, McCoy does not disclose the method according to claim 8 further comprising the step of associating an electronic address with said image content identifier.

30> Tobita discloses a method of associating an electronic address to an image content identifier for the purposes of allowing the image to be disclosed or emailed to only those people that have their email address linked to the image's identifier [paragraphs 0008, 0009, 0012, 0086, 0118]. As McCoy suggests including transaction parameters along with the images [McCoy - column 8 <lines 41-44>], it would have obvious to one of ordinary skill in the art to implement Tobita's electronic address association method into McCoy's image transmission method to prevent transmission of images to unauthorized people.

31> As to claim 10, McCoy discloses a system for automatically sharing images over a communication network, comprising:

obtaining at least one image identifier comprising an image content identifier [column 9 <lines 17-22> where: the fingerprint minutiae is comparable to the image content identifier];

analyzing digital images for determining if the said image content identifier substantially matches a portion of said images [column 10 <lines 47-49>]; and

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automatically forwarding said images that substantially match said image content identifier over said communication network [column 11 <lines 35-39>].

McCoy does not disclose the use of an electronic address that is associated with image identifier or to determine where to forward said images.

32> Tobita discloses a method of associating an electronic address to an image content identifier for the purposes of allowing the image to be disclosed or emailed to only those people that have their email address linked to the image's identifier [paragraphs 0008, 0009, 0012, 0086, 0118]. As McCoy suggests including transaction parameters along with the images [McCoy - column 8 <lines 41-44>], it would have obvious to one of ordinary skill in the art to implement Tobita's electronic address association method into McCoy's image transmission method to prevent transmission of images to unauthorized people.

33> As to claim 11, McCoy discloses the system according to claim 10 wherein said images are forwarded to fulfillment provider for providing goods and/or services with respect to said at least one digital image file [column 1 <lines 21-32> | column 2 <lines 3-6> | column 5 <lines 36-38> where: the service provided with respect to said digital image file is the rapid identification of personnel based on said digital image file].

34> As to claim 12, it does not teach or further define over the limitations recited in claim 10. Therefore, claim 12 is also rejected for the same reasons as set forth in claim 10, supra.

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35> As to claim 22, as it is a computer software products that perform the steps of the method of claim 10, it does not teach or further define over the limitations recited in claims 10. Therefore, claim 22 is rejected for the same reasons as set forth in claim 10, supra.

36> As to claim 26, McCoy does not disclose the method of claim 25 wherein said image icon includes the electronic address of said user where image is to be sent.

37> Tobita discloses a method of associating an electronic address to an image icon for the purposes of allowing the image to be disclosed or emailed to only those people that have their email (electronic) address linked to the image's identifier [Figure 4 | paragraphs 0008, 0009, 0012, 0086, 0118]. As McCoy suggests including transaction parameters along with the images [McCoy - column 8 <lines 41-44>], it would have obvious to one of ordinary skill in the art to implement Tobita's electronic address association method into McCoy's image transmission method to prevent transmission of images to unauthorized people.

38> Claim 30 is rejected under 35 U.S.C § 103(a) as being unpatentable over Tobita, in view of McCoy.

39> As to claim 30, Tobita does not disclose the method according to claim 29 wherein said content identifier is the appearance of an individual and said change is in appearance.

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40> McCoy discloses a method wherein a content identifier is the appearance of an individual and a change in the appearance updates said content identifier [column 1 <line 6> to column 2 <line 2>] for the purpose of keeping image identifiers for criminals and illegal immigrants up-to-date with their current appearance. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include McCoy's appearance update functionality in Tobita's content identifier and database update method for the obtained advantage of keeping Tobita's image identifiers current and up-to-date every time the associated image appearance is changed or updated.

### *Conclusion*

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S Patent No. 6,650,831 to Thompson [abstract | column 4 <lines 6-43> | column 7 <line 54> to column 8 <line 4>].

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dohm Chankong whose telephone number is (703)305-8864. The examiner can normally be reached on 8:00AM - 5:00PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on (703)305-8498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DC



FRANTZ B. JEAN  
PRIMARY EXAMINER